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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRY SCANZANO, LIN YU, ALAAELDIN A. ALY,
and SAMEH YAMANY

Appeal 2008-000849
Application 09/942,787
Technology Center 2100

Decided: July 31, 2009¹

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
HOWARD B. BLANKENSHIP, and STEPHEN C. SIU, *Administrative
Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Data (electronic delivery).

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-48. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

According to Appellants, the invention relates to database systems that provide for multiple but exclusive relationships between tables in a relational database.²

Exemplary Claim

12. A database system for providing multiple but exclusive relationships between tables in a relational database, comprising:

a relating table;

a plurality of related tables; and

means for selectively associating a foreign key value of a record in the relating table with a specific one of the plurality of related tables based on at least one attribute of the record containing the foreign key in the relating table so as to provide multiple but exclusive relationships between tables in the relational database.

Prior Art

The Examiner relies on the following prior art reference to show unpatentability:

Jorgensen

US 5,933,831

Aug. 3, 1999

² See Spec. 4:9-11.

Examiner's Rejections

The Examiner rejected claims 1-48 under 35 U.S.C. § 102(b) as being anticipated by Jorgensen.

THE REJECTION OVER JORGENSEN

Claims 1-48

ISSUE

The issue before us is whether the Examiner reached a proper final conclusion of anticipation for claims 1-48.

FINDINGS OF FACT

1A. In the Final Rejection at pages 4 and 6-7, the Examiner relied on (1) Figures 3A-3C and associated text; (2) Figure 4 and associated text; and (3) col. 2, lines 20-22 of Jorgensen to teach a

means for selectively associating a type attribute (or a foreign key value) of a record in the relating table with a specific one of the plurality of related tables based on at least one attribute of the record containing the foreign key in the relating table so as to provide multiple but exclusive relationships between tables in the relational database.

(Final Rejection 4).

1B. Further, the Examiner pointed to the "the entity relationship diagram produced by the foreign key icon & trigger processing of Fig(s). 3A-3C; Fig. 4 and associated texts" and found

the primary key icon represents an exclusive relationship between tables in the relation database because the primary key is unique in nature. The foreign key icon links the displayed table to a display of

another table in the entity relationship diagram containing the foreign key (e.g., col. 2, lines 20-22), thus, the icons that [include] keys and constraints represents multiple relationships between tables in a database.

(Final Rejection 4).

2. In the Appeal Brief, Appellants refer to Figures 3A-3C when arguing, with respect to claim 12 and similarly, with respect to claims 1 and 24, "that nothing in the cited portions of Jorgensen discloses or suggests the selective association of a foreign key in a relating table with a specific one of a plurality of related tables based on an attribute of the record containing the foreign key in the relating table" (*See App. Br. 7*).

3. In the Examiner's Answer, the Examiner found "[t]he claimed 'the selective associations of a foreign key' [is] met by the associations embodied in the clickable objects of the 'Keys and constraints column' (e.g., 210, Fig. 2)." Further, the Examiner found

the claimed 'a specific one of a plurality of related tables based on an attribute of the record containing the foreign key in the relating table' [is] clearly met by the description of Jorgensen's invention: 'When foreign key icon 214 is clicked, the parent table is displayed with the column of that table which is the foreign key highlighted[.]' (e.g., Johnson: col. 3, lines 57-59).

(Ans. 8).

4. In the Reply Brief, Appellants respond to the Examiner's finding in the Examiner's Answer that "the description of the 'Keys And Constraints' column 210 in which a foreign key icon can be clicked to display the relationship of table 202 with other hyperlinked tables as

disclosing the 'selectively associating a foreign key value'" (*See* Reply Br. 2).

5. The Examiner noted Appellants' Reply Brief (*See* Office Communication mailed May 1, 2007).

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 102, "[a] single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation." *Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005) (citation omitted).

"Anticipation of a patent claim requires a finding that the claim at issue 'reads on' a prior art reference." *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) ("In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.") (internal citations omitted).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants' Briefs to show error in the Examiner's proffered prima facie case.

ANALYSIS

We find that in the Final Rejection, the Examiner (1) relied on Figures 3A-3C and associated text, Figure 4 and the associated texts starting from col. 1, lines 22-53, and col. 2, lines 20-22 to teach "the selective association

of a foreign key in a relating table with a specific one of a plurality of related tables based on an attribute of the record containing the foreign key in the relating table," and (2) relied on the icons that include keys and constraints to teach multiple relationships between tables in a database (*See* FF 1A-1B).

However, in the Examiner's Answer, the Examiner found that "[t]he claimed 'the selective associations of a foreign key' [is] met by the associations embodied in the clickable objects of the 'Keys and constraints column' (e.g., 210, Fig. 2) (*See* FF 3).

Thus, the Examiner's findings in the Answer replace those of the Final Rejection by referring to the Keys and Constraints column as teaching "the selective association of a foreign key in a relating table with a specific one of a plurality of related tables based on an attribute of the record containing the foreign key in the relating table." (App. Br. 7).

We also find that Appellants, in the Reply Brief at page 2, provided an on-point response to the Examiner's new findings (*See* FF 4). However, we find that the Examiner only noted the Reply Brief, and did not address the Appellants' cogent response to the Examiner's new findings (*See* FF 5).

We find that the Examiner, in not responding to Appellants' arguments to the Examiner's supplemental findings, in essence invited this Panel to step into the Examiner's shoes and to address for the first time the Appellants' arguments. We decline that invitation. Based solely on the persuasiveness of Appellants' unaddressed arguments, the Examiner's rejection of claims 1-48 is reversed.

OTHER ISSUES

NEW GROUND of REJECTION

Claims 24-35 and 45-48

We make the following new grounds of rejection using our authority under 37 C.F.R. § 41.50(b).

Claims 24-35 and 45-48 are rejected under 35 U.S.C. § 101 for being non-statutory. Claims 24-35 and 45-48 recite a computer program product (*See App. Br. 21-34 and 26-27, Claims Appendix*). The Specification of the present application discloses that (1) “the present invention may take the form of a computer program product on a computer-usable storage medium having computer-usable program code embodied in the medium” (Spec. 7:22-24). Further, the Specification discloses that “[A]ny suitable computer readable medium may be utilized including hard [25] disks, CD-ROMs, optical storage devices, a transmission media such as those supporting the Internet or an intranet and/or magnetic storage devices” (Spec. 7:24-26).

As (1) the computer program product may be on a computer-useable storage medium, and (2) one of ordinary skill in the art would recognize that a computer-useable storage medium corresponds to a computer readable medium, we find that the Specification of the present application discloses that a computer program product may be on a transmission media.

Further, we find that a skilled artisan would have recognized that a transmission media corresponds to a signal. Thus, we find the Specification of the present application discloses that a computer program product may be on a signal.

Such a claim for computer instructions embodied in a signal only is not considered by this office to be statutory under 35 U.S.C. § 101. This policy

has recently been confirmed by the Court of Appeals for the Federal Circuit in *In re Nuijten*. “A transitory, propagating signal like *Nuijten*’s is not a ‘process, machine, manufacture, or composition of matter.’ Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” *In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

DECISION

We reverse the Examiner's rejection with respect to claims 1-48. Moreover, we have entered a new ground of rejection under 37 C.F.R. § 41.50(b) for claims 24-35 and 45-48 as failing to recite statutory subject matter under 35 U.S.C. § 101.

37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED
37 C.F.R. § 41.50(b)

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